

REMARKS

Claim Rejections

Claims 1-6 are rejected under 35 U.S.C. § 112, second paragraph. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Militello et al. Claims 2, 5, and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Militello et al. in view of Coe. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, as set forth in the outstanding Office Action and to include all of the limitations of the base claim and any intervening claims.

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-6 and has added new claims 7-12 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Claims 3 and 4 have been rewritten in independent form as new claims 7 and 8, respectively, to include the language of claim 1 and obviate the outstanding rejections under 35 U.S.C. § 112. It is believed that the subject matter of new claim 7 is commensurate with the subject matter of original claims 1 and 3. It is believed that the subject matter of new claim 8 is commensurate with the subject matter of original claims 1 and 4. Since no prior art was cited against the claims, it is believed the claims 7 and 8 are in condition for allowance.

The new claims 9-12 are directed toward a locating device for supporting a fan shaped blind connected to a top of a frame comprising: a retaining mount (31) inserted into an arched room located in a center of a bottom of the fan shaped blind

and connected to the frame; a first supporting board (32) removably connected to the retaining mount and located on a first side of the fan shaped blind; and a second supporting board (32) removably connected to the retaining mount and located on a second side of the fan shaped blind.

Other embodiments of the present invention include: the retaining mount having an arc top surface (311), a through hole (312) vertically protruding through a center thereof; the arc top surface of the retaining mount having a shape matching a shape of a top of the arched room of the fan shaped blind; and the first support board and the second support board have a pattern matching a pattern of the fan shaped blind.

Militello et al. teaches a shade for an arched window having a retainer (50) having a base (52), panels (54, 56), and a hump (60) located in a center of the base.

Militello et al. does not teach a retaining mount inserted into an arched room located in a center of a bottom of the fan shaped blind and connected to the frame; a first supporting board removably connected to the retaining mount and located on a first side of the fan shaped blind; a second supporting board removably connected to the retaining mount and located on a second side of the fan shaped blind; nor does Militello et al. teach the retaining mount having an arc top surface, a through hole vertically protruding through a center thereof.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Militello et al. do not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Militello et al. cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Coe teaches a collapsible blind for an arched window and is cited for teaching a fastening hole.

Coe does not teach a retaining mount inserted into an arched room located in a center of a bottom of the fan shaped blind and connected to the frame; a first supporting board removably connected to the retaining mount and located on a first side of the fan shaped blind; nor does Coe teach a second supporting board

removably connected to the retaining mount and located on a second side of the fan shaped blind.

Even if the teachings of Militello et al. and Coe were combined, as suggested by the Examiner, the resultant combination does not suggest: a retaining mount inserted into an arched room located in a center of a bottom of the fan shaped blind and connected to the frame; a first supporting board removably connected to the retaining mount and located on a first side of the fan shaped blind; nor does the combination suggest a second supporting board removably connected to the retaining mount and located on a second side of the fan shaped blind.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Militello et al. or Coe that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Militello et al. nor Coe disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: June 24, 2005

By:



Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707